

REMARKS

Claims 1-10 are pending in the application. Claim 4 have been amended to rewrite the claim in independent form, claim 1 has been canceled, leaving claims 2-10 for consideration upon entry of the present Amendment.

The Examiner has objected to the drawings. Applicants have amended Figure 5 as requested by the Examiner. Applicants respectfully request that the Examiner withdraw the objections.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Prior Art figures 5 and 6 in view of Yamada et al. (US 6,072,450) ("Yamada"). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 1 has been canceled. Thus, Applicants response is directed to claims 2 and 3. The Examiner has indicated that "Prior Art Figures 5-6 disclose that a digitizing apparatus for obtaining coordinate information (14), and display control circuit (13) for displaying an image on the display by determining timing [of] horizontal scanning and vertical scanning." The Examiner also asserts that Prior Art Figures 5-6 disclose that a digitizing processing circuit for generating coordinate information on the basis of change in detection output of the pen with respect to timing of display. Applicants respectfully traverse the Examiner's assertions regarding Applicants' Prior Art Figures 5 and 6.

According to the Applicants' admitted prior art, the display 11 is only for normal displaying function and coordinates are detected by a resistance sheet 12 provided to sense the position touched by the pen 5. See page 2, lines 8-23 of the Applicants' specification. Moreover, Yamada merely discloses an EL display and does not teach or suggest using a detector or a pen.

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Claim 2 includes the following limitation: "a detector in contact with the display surface of said display device for detecting an emissive state of a display pixel at the position of contact, wherein said plurality of display pixels to emit light in a predetermined sequence for obtaining coordinate information of the position of contact of the detector."

Claim 3 includes the following limitation: "a pen for contacting the display surface of said display and for detecting the emissive state of the display pixel at the position of contact; *

* * a digitizing processing circuit for generating coordinate information on the basis of change in detection output of said pen with respect to timing of horizontal scanning and vertical scanning of said display control circuit." These claims require that the detector or pen is used to detect the emissive state and that coordinates are determined on the basis of the detection state of the detector or pen and the light emitting timing of the display. None of the references teach or suggest those limitations.

Moreover, there is no motivation to combine Yamada with any prior art that utilizes a detector or a pen. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01. As explained above, Yamada merely discloses an EL display and does not teach or suggest using a detector or a pen. Accordingly, one skilled in the art would not combine Yamada with Prior Art figures 5 and 6 because there is no motivation to do so.

Prior Art figures 5-6, Yamada, and the knowledge generally available in the art at the time of the invention do not contain the suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references to reach the claimed subject matter. Applicants submit that the motivation for the limitations quoted above come from Applicants' disclosure.

Applicants further maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims. In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the

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invention and the prior art "as a whole," not from improper hindsight gained from consideration of the claimed invention. See *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

"[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution." *Id.*

In this case, the Examiner does not point to any reference that provides the teaching as to the above quoted limitations. Applicants submit that when AAPA and Yamada are applied in context, a person skilled in the art would not arrive at Applicant's claimed limitations.

Thus, claims 2 and 3 are patentable over Prior Art Figures 5 and 6 and Yamada. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection as to claims 2 and 3.

Claims 4-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Prior Art figures 5 and 6 in view of Yamada et al. (US 6,072,450) and Tomio et al. (US 5,745,085). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 4 has been rewritten in independent form. As explained above, Prior Art Figures 5 and 6 and Yamada do not teach or suggest that the pen is used to detect the emissive state and that coordinates are determined on the basis of the detection state of the pen and the light emitting timing of the display, as required by claim 4. Moreover, Tomio does not remedy this deficiency; thus, the references do not teach or suggest all of the limitations of claim 4. Claims 5-10 include all of the limitations of claim 4. Thus, Prior Art Figures 5 and 6, Yamada, and Tomio do not teach or suggest all of the limitations of

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claims 5-10. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection as to claims 4-10.

In addition, attached hereto is a marked-up version of the changes made to the application. The attached page is captioned "**Version with Markings to Show Changes Made.**"

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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MARKED UP VERSION TO SHOW CHANGES MADE**IN THE CLAIMS:**

Please amend claim 4 in "marked up" format, as follows:

4. (Marked up/Amended) A digitizing apparatus comprising:
- an electroluminescence display having a plurality of display pixels disposed in a matrix;
 - a pen for contacting the display surface of said display and for detecting the emissive state of the display pixel at the position of contact;
 - a display control circuit for displaying an image on said display by determining timing of horizontal scanning and vertical scanning and for causing said plurality of display pixels to emit light in dot sequence in accordance with the timing of horizontal scanning and vertical scanning;
 - a digitizing processing circuit for generating coordinate information on the basis of change in detection output of said pen with respect to timing of horizontal scanning and vertical scanning of said display control circuit;~~A digitizing apparatus according to claim 3 wherein said electroluminescence display comprises:~~
 - a plurality of display pixels disposed in a matrix and having an emissive layer disposed between a pair of electrodes;
 - a horizontal driver circuit for sequentially applying a voltage in accordance with image information to each column of said plurality of display pixels at the timing of horizontal scanning; and
 - a vertical driver circuit for driving said plurality of display pixels in row units at the timing of vertical scanning.

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